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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,331	07/18/2007	Brian E. Jones	GC819-2-US/B	7214

7590 02/16/2011
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EXAMINER

SWOPE, SHERIDAN

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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02/16/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,331	Applicant(s) JONES ET AL.	
	Examiner SHERIDAN SWOPE	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-114 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

With the filing of August 29, 2006, Claims 1-114 are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-43, 47-49, 53, 54, 59, 60, 70-106, and 109-114, drawn to a Micrococcineae serine protease polypeptide and compositions thereof.

Group II, claim(s) 44-46, 50-52, 55-58, 61-69 drawn to a polynucleotide encoding a Micrococcineae serine protease polypeptide, host cells, and methods of making the polypeptide.

Group III, claim(s) 107 and 108, drawn to a method of cleaning using a composition comprising a Micrococcineae serine protease polypeptide.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons. The technical feature linking Groups I-III appears to be that they all relate to serine proteases from Micrococcineae. However, serine proteases from Micrococcineae were known in the art. For example, Shimoi et al, 1992 teach a serine protease from *Rarobacter faecitabidus*, which anticipates Claim 1. Therefore Groups I-III share no special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Furthermore, the products of Groups I and II do not share a special common structural and functional feature while, the methods of Group III do not comprise all of the methods for making or using the products of Groups I and II. Accordingly, Groups I-III are not

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so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Species Election

The inventions listed as Groups I-III each comprise patentably distinct species of the generic inventions. Said, patentably distinct species are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention(s) to which the claims must be restricted.

If Group I is elected, elect:

- One specific Micrococcineae serine protease polypeptide (SEQ ID NO:), where every residue is designated, as encompassed by Claims 1-43, 47-49, 53, 54, 59, 60, 70-106, and 109-114 and the disclosure as a whole. The technical feature linking these inventions appears to be that they all relate to serine proteases from Micrococcineae. However, serine proteases from Micrococcineae were known in the art. For example, Shimoi et al, 1992 teach a serine protease from *R. faecitabidus*, which anticipates Claim 1.
- One specific type of compositions, e.g, cleaning composition, animal feed, pharmaceutical, etc, as encompassed by Claims 1-43, 47-49, 53, 54, 59, 60, 70-106, and 109-114 and the disclosure as a whole. The technical feature linking these species of inventions appears to be that they all relate to compositions comprising serine proteases from Micrococcineae. However, compositions comprising serine proteases from Micrococcineae were known in the art (Shimoi et al, 1992). Thus, the technical feature linking these species is not a special technical feature.

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If Group II is elected, elect:

- Polynucleotides encoding one specific variant Micrococcineae serine protease polypeptide (SEQ ID NO:), where every residue is designated, as encompassed by Claims 1-106 and 109-114 and the disclosure as a whole. The technical feature linking these inventions appears to be that they all relate to polynucleotides encoding variants of serine proteases from Micrococcineae. However, polynucleotides encoding variants of serine proteases from Micrococcineae were known in the art (Shimoi et al, 1992; Fig 2&7). Thus, the technical feature linking these species is not a special technical feature.

If Group III is elected, elect:

- One specific Micrococcineae serine protease polypeptide (SEQ ID NO:), where every residue is designated, as encompassed by Claims 1-43, 47-49, 53, 54, 59, 60, 70-114 and the disclosure as a whole. The technical feature linking these inventions appears to be that they all relate to methods for cleaning using a serine protease from Micrococcineae. However, the use of the *R. faecitabidus* serine protease of Shimoi et al would have been obvious to the skilled artisan since said protease is lytic to microorganisms (Fig 9). Thus, the technical feature linking these species is not a special technical feature.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to

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petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, **in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims.**

Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

To insure that each document is properly filed in the electronic file wrapper, it is requested that each of amendments to the specification, amendments to the claims, Applicants' remarks, requests for extension of time, and any other distinct papers be submitted on separate pages. It is requested that Applicants cite the serial number of the Application on every page of filed documents.

It is also requested that Applicants identify support, within the original application, for any amendments to the claims and specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 11-7:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Mondesi, can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SHERIDAN SWOPE/
Primary Examiner, Art Unit 1652